IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

INLINE CONNECTION CORP., Plaintiff,	)	
v.	)	C.A. No. 05-866 (JJF)
VERIZON INTERNET SERVICES, INC., et al., Defendants.	)	

INLINE'S OPPOSITION TO VERIZON'S
MOTION TO COMPEL INVALIDITY DISCOVERY

Verizon's motion (D.I. 101) seeks discovery unrelated to the well-defined issues this Court excepted from the stay in order to avoid loss of evidence. Moreover, the discovery Verizon seeks is of Inline's responsive contentions on possible invalidity affirmative defenses under Section 112 – inadequate written description and lack of enablement - that have not been articulated by Verizon. Thus, Inline need have no contentions on those matters unless and until Verizon articulates such defenses and gives contentions as to their alleged bases so that Inline has something to which to respond.

BACKGROUND

Verizon argued that the stay should not extend to discovery regarding events more than eight years old and that further delay would risk the loss of evidence of "prior art systems" that were "15 to 35 years old" because "the relevant third-party documents and knowledgeable individuals are extremely difficult to locate." (D.I. 82, at 9, 11).[1] The Court agreed, determining that it would not "allow Defendants' evidence to continue to deteriorate" (D.I. 92, at 4).

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[1] Verizon also said it needed old evidence relating to the making of the inventions, inventorship, public disclosures, offers for sale and ownership. These issues have nothing to do with Verizon's interrogatories 1 and 5 at issue on this motion.

The discovery Verizon seeks, however, does not relate to events from the distant and dimming past. Rather, it asks Inline to state *contentions* as to whether the patents provide sufficient information to describe and enable the inventions. Notably, Verizon did not on the motion to stay identify defenses under Section 112 of inadequate written description and lack of enablement. In particular, Verizon did not (and could not) argue that any such defenses would be subject to loss of evidence and should be exempt from a stay. (D.I. 82, pp. 5-7).

A. Interrogatory No. 1 (Written Description)

Interrogatory No. 1 seeks Inline's contentions as to where in the specification (by column and line, or reference numbers or figures) each claim element finds support in the specification. This could only be relevant to whether the patent satisfies the requirements of 35 U.S.C. § 112, ¶ 1 that a patent specification "contain a written description of the invention." Section 112(1) is satisfied if the specification describes "an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed." *Cordis v. Medtronic, Inc.*, 339 F.3d 1352, 13654 (Fed. Cir. 2003). The inventor "is not required to describe in the specification every conceivable and possible future embodiment of his invention." *Rexnord Corp.v. Laitrim Corp.*, 274 F.3d 1336, 1334 (Fed. Cir. 2001).

Insufficient written description is an affirmative defense that must be proven "by clear and convincing evidence." *Cordis*, 339 F.3d at 1364. To bring this defense, Verizon would have to identify some specific aspect of the claims allegedly unsupported by the specification and explain why. The issue is for the jury (*id.)*, and is typically the subject of expert testimony as to the conclusions a person skilled in the art would draw from the specifications.

Although Verizon's motion to compel asserts that one of its "invalidity defenses is that Inline's asserted patents fail to contain a proper 'written description of the invention'"

(D.I. 101, pp. 1-2), Verizon has not identified any specific failure. In particular, as noted in Inline's motion to compel (D.I. 104), Verizon has pled invalidity only cursorily and it has given no contentions on invalidity in discovery. Yet Interrogatory No. 1 would require Inline to match thousands of lines of the specifications against the hundreds of specific patent claim elements to show where the specifications provide a written description of each claim element. Such an exercise can have no legitimate purpose. Certainly Verizon is free to try to develop a written description defense if it can, and it does not need contentions from Inline to try to do so.

B. Interrogatory No. 5 (Enablement)

Interrogatory No. 5 seeks Inline's contentions on how the "specification and drawings of [the '718 patent] would enable" the transmission of certain digital signals. This interrogatory is plainly directed to the requirement that the specification enable the invention. 35 U.S.C. § 112, ¶ 1. The test is whether a person skilled in the art, combining the patent specification with all information already known to one skilled in the art, would have been able to practice the invention without "undue experimentation." *Kotio Mfr. Co., Ltd. v. Turn-Key Tech, LLC*, 381 F.3d 1142, 1155 (Fed. Cir. 2004).

Again, Verizon would need to proffer and prove lack of enablement by clear and convincing evidence. *Plant Genetic Systems, N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1342 (Fed. Cir. 2003). It would be up to Verizon to come forward with some specific way in which the specification is allegedly nonenabling, which it has not done. Yet Verizon asks Inline to provide detailed contentions on the topic now. Again, there can be no justification for putting Inline to the burdensome task of detailing how the specification enables the invention. Verizon does not need contentions from Inline to try to develop a nonenablement defense (and Verizon already has Inline's documents relating to the making of the invention).

ARGUMENT

This is not the type of fact discovery the Court exempted from the stay. Neither interrogatory concerns "events more than eight years ago" or prior art whose documentation is fading. These interrogatories instead seek Inline's contentions on highly technical patent requirements that are not in issue. Resolution of any such defenses (if articulated) would undoubtedly depend upon expert testimony concerning how one skilled in the art would understand these patents. This is the sort of question that, if presented, would make sense to address after the stay is lifted.[2]

Moreover, Verizon's discovery as crafted would impose burdensome make work on Inline with no justification under any circumstance. Verizon bears the burden of proving lack of written description and nonenablement. To meet its burden, it would have to identify specifically what it would contend is not described or enabled.. Inline should only have to give rebuttal contentions directed to specific arguments Verizon might make. Thus, if the Court does not stay this discovery – and Inline submits that it should – Inline asks at a minimum that Verizon be required to identify specific written description or enablement defenses it plans to pursue as sought in Inline's motion to compel and provide its contentions (D.I. 104). Any further discovery of Inline (including interrogatories 1 and 5) should be limited to that reasonably tailored to explore any defenses Verizon actually proceeds to articulate-.

Accordingly, Inline asks that Verizon's motion be denied.

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2 Verizon's claim that it needs written description contentions to identify relevant prior art (D.I. 101, at 2) is nonsensical. The difference in possible priority dates (December 1991 as compared to July 1989) is small enough that it is unlikely Verizon would ignore possible art based on any Inline contentions as to the support in the specifications. Moreover, Verizon will be free to make its own contentions and it is unlikely it will live by Inline's, if Verizon finds it in its interest to argue for a later critical date for prior art.

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CERTIFICATE OF SERVICE

I, the undersigned, hereby certify that on May 8, 2006, I electronically filed the foregoing with the Clerk of the Court using CM/ECF which will send notification of such filing to the following:

Jeffrey B. Bove
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